

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re _____)
)
)

DECISION ON REQUEST FOR FEE REIMBURSEMENT

, petitioner, requests reimbursement of various fees incurred in his efforts to be admitted to practice before the Patent and Trademark Office (PTO) in patent matters. The request is denied.

BACKGROUND

An applicant for registration to practice before the PTO in patent matters must achieve a passing grade of 70 on both the morning and afternoon section of a registration examination. Petitioner sat for the May 3, 1995, registration examination. He received a passing score on the morning section of the examination, but a failing score (55) on the afternoon section. On October 10, 1995, Petitioner requested regrade of the afternoon section of the examination. See 37 C.F.R. § 10.7(c). Petitioner's regrade request was accompanied by the required \$130 fee. On November 20, 1995, a staff member in the Office of Enrollment and Discipline (OED) issued a decision on Petitioner's request, increasing his score by 5 points, to 60. On December 14, 1995, Petitioner requested reconsideration by the Director of OED (Director). On August 16, 1996, the Director issued her decision, increasing Petitioner's score by 2 points, to 62. On September 9, 1996, Petitioner requested the Commissioner's review of the Director's August 16, 1996, decision. See 37 C.F.R. 10.2(c). His petition was accompanied by the required \$130 fee. On July 15, 1997, the Commissioner dismissed the petition because it had been rendered moot. It had

been rendered moot because, in the interim, Petitioner applied to take, and successfully sat for, the afternoon section of the August 28, 1996, registration examination. 37 C.F.R. 10.7(b). His application for registration was accompanied by the required \$300 admission fee.

Petitioner requests reimbursement of the \$130 fee that accompanied his October 10, 1995, petition for regrade, the \$130 fee that accompanied his September 9, 1996, petition to the Commissioner, and his \$300 admission fee to the August 28, 1996, examination.

DISCUSSION

Title 35 U.S.C. § 42(d) permits the Commissioner to refund “any fee paid by mistake or any amount paid in excess of that required.” 35 U.S.C. § 42(d). Petitioner did not pay (nor does he contend) that he paid fees in excess of that required at the time the fees were paid. Rather, Petitioner states:

I acknowledge that I did pass the August 1996 exam, but had my request for review or appeal been favorably granted, I would not have had to have taken the August 1996 exam, and would not have incurred the fee expenses concerning the appeal and Petition. Of course, if my appeal had been denied, I understand that those fees would be lost by me. However, it seems that when the Commissioner has voluntarily “mooted” my appeal, when I had no further choice but to take the August 1996 exam, while my appeal was still pending, some 26 months after the May 1995 exam, which forced me to take the next available exam, namely, the August 1996 exam, that I should be entitled to reimbursement of the fees incident to having to re-take the exam and fees incident to the appeal and Petition.

Thus, Petitioner’s argument for reimbursement rests on the premise that because he successfully sat for the August 28, 1996, examination, then he is entitled to have his fees refunded for all petitions related to the May 3, 1995, examination, as well as the admission fee for the August 28, 1996, examination. In other words, the only fee he properly paid the PTO was the admission fee for the May 3, 1995, examination. The remaining fees should be refunded.

Petitioner's argument is without merit. Petitioner was confronted with a failing score on the afternoon section of the May 3, 1995, examination--a score which he believed in error. Petitioner had two choices--petition the Director, and then, if necessary, the Commissioner on the perceived errors or retake the afternoon section of the examination. Each choice had certain time limits that required the payment of a fee in order to file a paper and preserve legal rights. Petitioner choose to do both, and in so doing, incurred the respective fees.

For example, while awaiting the Director's decision on his petition for regrade, he filed his application for the afternoon section of the August 28, 1996, examination. Upon learning that he was unsuccessful in his petition for regrade, Petitioner sat for the afternoon section of the August 28, 1996, examination. While awaiting his score on the afternoon section of the examination, and to preserve his legal rights, Petitioner filed his petition to the Commissioner for review of the Director's decision on his petition for regrade. See 37 C.F.R. § 10.2(c) (petition for review of Director's decision must be filed within 30 days of the decision). Ultimately, he was successful on his retake of the afternoon section of the examination. Thus, Petitioner has received what he sought--admission to practice before the PTO in patent matters. Accordingly, Petitioner's \$130 fee for regrade, \$300 fee for the August 28, 1996, examination, and \$130 fee for review of the Director's decision on regrade were not fees paid by mistake or in excess of what was required. See Miessner v. United States, 108 USPQ 6, 7 (D.D.C. 1955) (refund of appeal fee paid after examiner's final rejection but prior to examiner's withdrawal of final rejection was not fee paid by mistake).

Petitioner also argues that "mooting" his petition to the Commissioner was inappropriate without reimbursement of the fees because if his petition had been granted he would have been

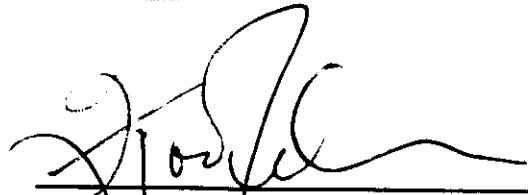
reimbursed the fees. Petitioner states that he knows "for a fact that prior successful exam appellants have had their exam fee and fees incident to appeal returned and reimbursed to them." A petition for regrade seeks a determination that the petitioner possesses one of the "necessary qualifications" needed to render patent applicants valuable assistance. 35 U.S.C. § 31. See also 37 C.F.R. § 10.7(b). In the instant case, such a determination was made when Petitioner successfully sat for the morning section of the May 3, 1995, examination and the afternoon section of the August 28, 1996, examination. See Brownlow v. Schwartz, 261 U.S. 216, 217 (1923) (ordering dismissal of a petition because relief sought by petitioner had already been granted, thereby, rendering the issue moot). See also Mills v. Green, 159 U.S. 651, 653-654 (1895) (holding that when "intervening event is owing either to the plaintiff's own act or to a power beyond the control of either party, the court will stay its hand"). Thus, dismissing Petitioner's September 9, 1996, petition for review of the Director's August 16, 1996, decision on regrade as moot was appropriate.

In addition, Petitioner is incorrect when he states that had his petition been granted, he would have been reimbursed his fees. As discussed above, none of the fees were paid by mistake or in excess of what was required. Petitioner is also mistaken about the return of fees to prior applicants in his situation. The PTO does not return examination fees to applicants who have sat for the examination.

CONCLUSION

Petitioner has failed to show that he paid the relevant fees by mistake. Accordingly, it is ORDERED that the request for reimbursement is denied.

JUL 16 2008

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

Q. TODD DICKINSON

**Deputy Assistant Secretary of Commerce and
Deputy Commissioner of Patents and Trademarks**